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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,057	06/02/2005	Calvani Menotti	2818-236	8374
23117 7590 10/16/2008 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
HUANG, GIGI GEORGIANA				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
10/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/537,057

**Applicant(s)**

MENOTTI ET AL

**Examiner**

GIGI HUANG

**Art Unit**

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 6/2/2005.

## **DETAILED ACTION**

### ***Status of Application***

1. Claims 1-5 are present for examination at this time.

### ***Claim Objections***

2. Claim 5 is objected to because of the following informalities: Claim 5 is missing a period at the end of the claim. It also appears to be missing the phrase "sulphonate, magnesium 2-amino-ethane sulphonate, choline tartrate and trichloroacetate."

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The factors to be considered in determining whether a disclosure meets the enablement requirements of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir., 1988). The court in *Wands* states, "Enablement is not precluded by the necessity for some experimentation, such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue', not 'experimentation'" (*Wands*, 8 USPQ2d 1404). Clearly, enablement of a claimed invention cannot be predicated on the basis of quantity of experimentation required to make or use the invention. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations" (*Wands*, 8 USPQ2d 1404). Among these factors are:

(1) the nature of the invention; (2) the breadth of the claims; (3) the state of the prior art; (4) the predictability or unpredictability of the art; (5) the relative skill of those in the art; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

While all of these factors are considered, a sufficient amount for a *prima facie* case is discussed below.

*(1) The nature of the invention and (2) the breadth of the claims:*

The claims are drawn to a method of treating glaucoma with the administration of a therapeutically effective amount of propionyl L-carnitine or its pharmaceutically acceptable salt. Thus, the claims taken together with the specification imply that the administration of a therapeutically effective amount of propionyl L-carnitine can treat all forms of glaucoma.

*(3) The state of the prior art and (4) the predictability or unpredictability of the art:*

The state of the prior art is that glaucoma is an eye condition characterized by raised intraocular pressure which can damage the optic nerve if untreated (see The Royal Society of Medicine). Glaucoma treatment involves the use of drugs to lower the raised intraocular pressure such as beta-blockers, sympathomimetics, carbonic-anhydrase inhibitors, and others. The drug chosen is dependent on the type of glaucoma. The state of the art is that reduction of intraocular pressure is the only clinically proven treatment (see The Royal Society of Medicine and Merck Manual).

*(5) The relative skill of those in the art:*

The relative skill of those in the art is high.

*(6) The amount of direction or guidance presented and (7) the presence or absence of working examples:*

The specification has provided guidance for neuroprotection of the optic nerve to some degree in the presence of glaucoma.

However, the specification does not provide for guidance and enablement for the treatment of glaucoma. The specification provides examples that showed some neuroprotection of the astrocytes in the presence of the induced IOP with methylcellulose (MTC) as no necrotic cells were detected. However, example 1 does not indicate how long the IOP was maintained for the groups and if the duration of the increased intraocular pressure was the same or different for group 2 and 3. If the duration for the elevated IOP was different for the two groups, it would not be an accurate comparative, and as it is unclear what the duration was, it is unclear if an adequate amount of time was present to allow a demonstration of necrosis and does not allow one of skill in the art to duplicate the example.

The examples, particularly Example 3, shows that there was better perfusion for neuroprotection but no significant decrease in the intraocular pressure which is the only clinically proven means of treatment (Page 11). There are glaucoma treatments that improve aqueous outflow, reduce the production of the aqueous, or both to reduce the intraocular pressure (see Mayo Clinic sheet) but the Example 3 only shows better perfusion which should reduce the pressure but does not. Additionally, the example does not address if the patients were being treated with any glaucoma drugs at the time as that would affect the results since the specification states that the subject had stable glaucoma which means glaucoma was stable and present prior to the test, and stable and present after the test with the propionyl L-carnitine. As a result, the glaucoma has

not been treated but neuroprotection of the optic nerve in the presence of glaucoma is shown.

*(8) The quantity of experimentation necessary:*

Considering the state of the art as discussed by the references above, particularly with regards to using the invention and the high unpredictability in the art as evidenced therein, and the lack of guidance provided in the specification, one of ordinary skill in the art would be burdened with undue experimentation to practice the invention commensurate in the scope of the claims.

***Conclusion***

5. Claims 1-5 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIGI HUANG whose telephone number is (571)272-9073. The examiner can normally be reached on Monday-Thursday 8:30AM-6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fredrick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GH  
/Zohreh A Fay/  
Primary Examiner, Art Unit 1612